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| 09/898,813 | 07/05/2001 | Susan T. Tingey | 82907RLO | 3223 |

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|---|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 2616 | |

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/898,813 | TINGEY ET AL. | |
| | Examiner | Art Unit | |
| | Heather R. Jones | 2616 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *05 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *7/5/2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/20/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

   a. Page 1, line 13: delete the word "signal" after the word "analog".

   b. Page 10, line 19: change "410" to –408--.

   Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

If in claims 12 and 13 the applicant is attempting to claim the memory storage product as being the material produced by the methods of recording recited in claims 1 and 3 respectively, claims 12 and 13 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject

matter. These claims do not fall within an enumerated statutory category; do not cover a 101 judicial exception or a practical application. Thereof, as required in the Interim Guidelines for Examination published in the OG of November 22, 2005. These claims recite only nonfunctional descriptive material and therefore are nonstatutory.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1, 3, 4, 6-9, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilman et al. (U.S. Patent 6,208,770) in view of Koyata et al. (U.S. Patent 6,462,753).

Regarding claim **1**, Gilman et al. discloses a method of having enabling software and images on a removable storage medium, comprising the steps of: providing a plurality of digital files representing colored digital images; transferring such digital files onto the removable storage medium; and providing enabling software and transferring such software onto the removable storage medium (Fig. 4; col. 8, lines 42-60). However, Gilman et al. fails to disclose a method of recording audio and having audio enabling software on a removable storage medium.

Referring to the Koyata et al. reference, Koyata et al. discloses a method of recording audio and having audio enabling software on a removable storage medium (abstract; col. 4, lines 51-55 - audio software on a removable storage medium).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of providing audio enabling software on a removable storage medium as taught by Koyata et al. on the removable storage medium disclosed by Gilman et al. in order to make a slideshow by providing audio along with the images.

Regarding claim **3**, Gilman a method of having enabling software and images on a removable storage medium, comprising the steps of: providing a plurality of digital files representing colored digital images; transferring such digital files onto the removable storage medium; and providing print enabling software and transferring print enabling software onto the removable storage medium (Fig. 4; col. 8, lines 42-60). However, However, Gilman et al. fails to disclose a method of recording audio and having audio enabling software on a removable storage medium.

Referring to the Koyata et al. reference, Koyata et al. discloses a method of recording audio and having audio enabling software on a removable storage medium (abstract; col. 4, lines 51-55 - audio software on a removable storage medium).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of providing audio enabling software on a removable storage medium as taught by Koyata et al. on the removable storage medium disclosed by Gilman et al. in order to make a slideshow by providing audio along with the images.

Regarding claim **4**, Gilman et al. in view of Koyata et al. discloses all the limitations as previously discussed with respect to claim 3 as well as further including using the audio enabling software to produce audio information and transferring such audio information onto the removable storage medium which already includes the audio enabling software and the print enabling software Gilman et al. discloses storing images on removable storage medium (col. 8, lines 53-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have stored the audio files along with the image files in order to keep all files together to easily display a slideshow presentation.

Regarding claim **6**, Koyata et al. in view of Gilman et al. discloses all the limitations as previously discussed with respect to claim 3 including that the removable storage medium is a write-once disc (Gilman et al.: col. 3, lines 5-7).

Regarding claim **7**, Koyata et al. in view of Gilman et al. discloses all the limitations as previously discussed with respect to claim 3 including that the audio software is prepressed at the time the write-once disc is manufactured (Gilman et al.: col. 3, lines 7-13).

Regarding claim **8**, Koyata et al. in view of Gilman et al. in view of Anderson et al. discloses all the limitations as previously discussed with respect to claim 3 as well as further providing a computer which responds to the audio enabling software on the removable storage medium to record audio information onto the removable storage medium (Gilman et al. discloses a computer (14) that responds to the enabling software and records information onto a removable storage medium (18). Koyata et al. discloses a computer (1) that responds to the audio enabling software and records audio information onto a removable storage medium.).

Regarding claim **12**, claim 12 is a memory storage product corresponding to the method claim 1. Therefore, claim 12 is analyzed and rejected as previously discussed with respect to claim 1. Furthermore, Gilman et al. discloses the memory storage product.

Regarding claim **13**, claim 13 is a memory storage product corresponding to the method claim 3. Therefore, claim 13 is analyzed and rejected as previously discussed with respect to claim 3. Furthermore, Gilman et al. discloses the memory storage product.

7. Claims 2, 5, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilman et al. in view of Koyata et al. as applied to claim 1 above, and further in view of Anderson et al. (U.S. Patent 6,839,059).

Regarding claim **2**, Gilman et al. in view of Koyata et al. discloses all the limitations as previously discussed with respect to claim 1 except Gilman et al. in

view of Koyata et al. fails to explicitly disclose using the audio enabling software to produce audio information for at least one of the digital files and recording such audio information onto the removable storage medium.

Referring to the Anderson et al. reference, Anderson discloses recording audio clips with corresponding images and storing them together (Fig. 2; steps 46-50 and 66).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teaching of attaching audio clips with images and storing them in the same location as taught by Anderson et al. with the removable storage medium disclosed by Gilman et al. in view of Koyata et al. in order to keep all files together to easily display a slideshow presentation.

Regarding claim **9**, Gilman et al. in view of Koyata et al. discloses all the limitations as previously discussed with respect to claims 3 and 8 as well as including a display coupled to the computer (Gilman et al.: display is on the computer (14)). However, Gilman et al. in view of Koyata et al. fails to disclose the audio enabling software further enabling the digital files to be viewed on the monitor and selected for audio recording.

Referring to the Anderson et al. reference, Anderson et al. discloses enabling software enabling the digital files to be viewed on the monitor and selected for audio recording (Fig. 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teaching of viewing the images selected for audio recording as taught by Anderson et al. with the enabling software disclosed by Gilman et al. in view of Koyata et al. in order to allow the user to correctly select the right images the user is recording audio clips for.

Regarding claim **10**, Gilman et al. in view of Koyata et al. in view of Anderson et al. discloses all the limitations as previously discussed with respect to claims 3, 8, and 9 including that the audio enabling software further enables a plurality of digital files to be selected for recording a single audio recording in association with the plurality of digital files (Anderson et al.: Fig. 2, steps 46-50).

Regarding claim **11**, Gilman et al. in view of Koyata et al. in view of Anderson et al. discloses all the limitations as previously discussed with respect to claims 3 and 8-10 including that the enabling software further enables the plurality of digital files to be automatically viewed in a sequence as the single audio recording is played (Anderson et al.: col. 4, lines 47-50).

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilman et al. in view of Koyata et al. as applied to claims 3 and 4 above, and further in view of Hu (U.S. Patent 6,990293).

Regarding claim **5**, Gilman et al. in view of Koyata et al. discloses all the limitations as previously discussed with respect to claims 3 and 4 as well as disclosing print enabling software for producing a print from the digital files

(Gilman et al.: Fig. 3). However, Gilman et al. in view of Koyata et al. fail to disclose print enabling software for producing a print from the audio information, wherein the print includes an audio data code area which encodes the audio information in machine readable format.

Referring to the Hu reference, Hu discloses a print enabling software for producing a print from the audio information, wherein the print includes an audio data code area which encodes the audio information in machine readable format (col. 5, lines 24-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the print enabling software as taught by Hu with the print enabling software disclosed by Gilman et al. in view of Koyata et al. in order to include the audio information with the prints.

## *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Parulski et al. (U.S. Patent 5,595,389) discloses software that is prepressed at the time the disc is manufactured, and only the digital images are written to the disc as the film is scanned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather R. Jones whose telephone number is 571-272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Heather R Jones
Examiner
Art Unit 2616

HRJ
January 24, 2006

James J. Groody
Supervisory Patent Examiner
Art Unit 2616